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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREJ GREGOV, ANDREW HARBICK, GREG LINDEN,
JONATHAN PAK, and JOSH PETERSEN

Appeal 2011-006565
Application 09/648,314
Technology Center 2100

Before JOSEPH L. DIXON, STEPHEN C. SIU, and
JAMES R. HUGHES, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

A Patent Examiner rejected claims 15-16, 27-35 and 40-51. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

A. INVENTION

The invention at issue on appeal is directed to the field of electronic marketing, and, more particularly, to the field of product recommendations. (Spec.1.)

B. ILLUSTRATIVE CLAIM

Claim 15, which further illustrates the invention, follows.

15. A method in a computing system for generating item recommendations for a user, comprising:

receiving requests from the user to display information about each of a plurality of items;

selecting as seed items the plurality of items that were displayed;

generating a list of recommended items each based on the selected seed items, wherein the generated list does not contain the selected seed items; and

displaying the generated list of recommended items to the user.

C. REFERENCES

The Examiner relies on the following references as evidence:

NONE

D. REJECTIONS

A new ground of rejection for claims 15-16, 27-35 and 40-51 was entered under 35 U.S.C. § 112, first paragraph, because the claim limitation "the generated list does not contain the selected seed items" recited in independent claims has not met the written description requirement under 35 U.S.C. § 112, first paragraph.

ISSUE

Has the Examiner set forth in a sufficient showing of a lack of written description of the claimed invention in light of Appellants' amended showing of support for the claimed invention?

PRINCIPLES OF LAW

112 first paragraph, Written Description

The test for written description is summarized in *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (internal quotation marks and citations omitted):

In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide in *haec verba* support for the claimed subject matter at issue. . . . Nonetheless, the disclosure must . . . convey with reasonable clarity to those skilled in the art that . . . [the inventor] was in possession of the invention. . . . Put another way, one skilled in the art, reading the original disclosure, must immediately discern the limitation at issue in the claims. . . . That inquiry is a factual one and must be assessed on a case-by-case basis.

There is no word for word or “*ipsis verbis*” requirement for the written description portion of 35 U.S.C. § 112, first paragraph. *See Union Oil Co. v. Atlantic Richfield Co.*, 208 F.3d 989, 1000 (Fed. Cir. 2000) (The invention claimed does not have to be described in *ipsis verbis* in order to satisfy the written description requirement).

ANALYSIS

In our prior decision, Appeal Number 2009-001176, decided April 20, 2010, we reversed the prior art rejection and entered a new ground of rejection under 35 U.S.C. §112, first paragraph since we did not find written description support for the claimed limitation "the generated list does not contain the selected seed items" where Appellants had indicated. We based our rejection upon Appellants' Summary of the Claimed Invention which

indicated that the claimed subject matter was supported by the Specification at page 1 and figure 5 (Prior Appeal Brief 3).

The present Appeal Brief indicates that the corresponding support for the claimed limitation may be found on page 7 of the Specification corresponding to figures 6 and 7. Furthermore, Appellants' corresponding correlation of a majority of the claim elements for the independent claims has been modified from that set forth in the prior Appeal Brief. Therefore, we evaluate Appellants' present correlation and arguments thereto. The Examiner maintains that the written description support for the claimed limitation is lacking based in part on the disclosure with regards to figures 4, 5, 6, and 7. (Ans. 3-10). We find the discussion is contrary to the express written description support proffered by Appellants in the present Appeal Brief corresponding to figures 6 and 7. While we agree with the Examiner that figures 4 and 5 and the corresponding disclosure in Appellants' Specification appears to support the Examiner's position, figures 6 and 7 and the corresponding disclosure of the Specification clearly support Appellants' position. Appellants set forth persuasive arguments at pages 9-16 of the Appeal Brief. Therefore, we cannot sustain the rejection of claims 15, 16, 27-35, and 40-51 based upon a lack of written description support based upon Appellants' arguments in the present Appeal Brief.

CONCLUSION

For the aforementioned reasons, the Examiner has not shown that Appellants lacked of written description support for claims 15, 16, 27-35, and 40-51.

ORDER

We reverse the written description rejection of claims 15, 16, 27-35,
and 40-51.

REVERSED

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